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1 RECORD OF ORAL HEARING
2 U.S. PATENT AND TRADEMARK OFFICE

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5 BEFORE THE BOARD OF PATENT APPEALS
6 AND INTERFERENCES

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9 *Ex parte* JEHAN CLEMENTS

10 _____
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12 Appeal 2010-009514
13 Application 10/801,401
14 Technology Center 3700

15 _____
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17 Oral Hearing Held: November 5, 2012

18 _____
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20 Before PHILLIP J. KAUFFMAN, MICHAEL L.
21 HOELTER, and HYUN J. JUNG, *Administrative Patent*
22 *Judges.*

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24 APPEARANCES:

25
26 ON BEHALF OF THE APPELLANT:

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33

1 The above-entitled matter came on for hearing on
2 Monday, November 5, 2012, commencing at 1:25 p.m., at
3 the U.S. Patent and Trademark Office, 600 Dulany Street,
4 Alexandria, Virginia, before Steve Garland, Notary Public.

5

6 P R O C E E D I N G S

7 THE USHER: Good afternoon. Calendar Number
8 27, Appeal Number 2010-9514, Ms. Amoroso.

9 JUDGE KAUFFMAN: Thank you.

10 MS. AMOROSO: Good afternoon.

11 JUDGE KAUFFMAN: Judge Hoelter is joining us
12 from Memphis.

13 JUDGE HOELTER: Good afternoon.

14 MS. AMOROSO: Good afternoon.

15 JUDGE KAUFFMAN: We're familiar with your case
16 and we're ready to listen and you have about 20 minutes.

17 MS. AMOROSO: Okay, great. So in my view, the
18 Examiner has not established a prima facie case of
19 obviousness for three main reasons. First, the combination
20 of references does not disclose every aspect of the pending
21 claims.

22 Second, the Examiner's obviousness rejection is what

1 I believe a textbook example of impermissible hindsight
2 reasoning. He merely combined isolated elements from five
3 references, some of them clearly divergent or non-
4 analogous, and he misapplied the leeway accorded by the
5 Supreme Court in *KSR v. Teleflex* to make conclusory
6 assertions that a skilled artisan would have combined them
7 precisely the way according to the pending claims. And I
8 think it's clear that the Examiner used information gleaned
9 from the application itself in making the obviousness
10 rejections.

11 And third, the Examiner's reasons for combining the
12 references are generic and they're not sufficiently rational
13 under the *KSR* standard. Under the Examiner's reasoning it
14 would be obvious to use computer software to publish any
15 storybook because it would make it more efficient or more
16 professional-looking. If this reasoning stands it follows that
17 no computer-assisted process would've ever have been
18 patentable because this reasoning can be applied to virtually
19 almost any invention.

20 But before I get into the details of the arguments I'd
21 like to give you just a very brief overview of the present
22 invention. So the present claims generally cover a method

1 and a kit for producing a story-telling book using software.
2 So the computer accepts a user's inputs into a series of blank
3 storybook screens. And the inputs that the user puts in to
4 each storybook screen represents the minimum amount of
5 inputs that are necessary for the computer to then
6 automatically generate content, automatically generate
7 pages, for a particular type of storybook.

8 And the storybook is one where the images and then
9 images and text are arranged in what's called diametric
10 contraposition. And this is for ease of reading a storybook
11 to an audience. And I have a demonstration here that was
12 something similar was shown to the Examiner. So basically
13 when a teacher or somebody is reading a book to students
14 you have to open the book and either crane around and read
15 that way or, if you're tall enough, which I'm not, look down
16 that way.

17 So the invention here solves that problem by
18 designing a book where the image, which is what usually the
19 children want to see, is on one page and then the text and a
20 smaller version of the image is on a page that is
21 diametrically contraposed so you can read your book to the
22 children, see the image, not lose your place, and all they see

1 are the images on the front page. So --

2 JUDGE KAUFFMAN: The visual aide you're
3 holding now is a lot like your Figure 5 in the specification?

4 MS. AMOROSO: Similar, yes. Similar to Figure 5
5 in the specification. This isn't the book that was generated
6 using the software of the invention, but this is what
7 diametric contraposition is.

8 So this software aids in that generation by
9 automatically generating content. So there's a first set of
10 inputs, that's in the claim, where the user puts in author
11 information and title information and an image, and then a
12 cover page is automatically generated with the image and
13 the title and the author, and then a title page is generated on
14 the backside of that page. And then an additional part of the
15 title page is on the front side of a second page. And this is
16 just from one set of inputs. All of this content is generated
17 by the software.

18 And then there's a second set of inputs where the user
19 puts in an image and puts in corresponding text, and then the
20 software automatically generates these pages in diametric
21 contraposition. So it enlarges the image on the one side and
22 then on the subsequent page, the front side of the subsequent

1 page, it reduces the image and puts text in. So you put it in
2 once and it automatically generates these additional pages of
3 content.

4 And also, the computer automatically generates one or
5 more indicia on each of the tops of the pages that tell the
6 user, who is going to be primarily a child, how to assemble
7 the pages once they are printed out from the computer so
8 that they are correctly in this diametric contraposed viewing
9 method. So then the computer then allows the user to print
10 the pages for binding in the correct format.

11 So that's a brief overview of the imaging.

12 And so turning to the main argument, the combination
13 of references the Examiner cited does not teach every
14 limitation of the pending claims. None of the references,
15 including the primary reference, teach that a single set of
16 inputs can automatically generate pages; in other words,
17 generate additional product than what was inputted. So the
18 Examiner primarily relies on the Gonzalez reference, which
19 is the published application, 202-016-9603. And Gonzalez,
20 when read as a whole, describes a software system primarily
21 for managing workflow among an author, an editor, and a
22 publisher for website publishing. So it provides templates in

1 which an author inputs content into a preformed template for
2 viewing on a website. But the same content that you put in
3 is what you see on the website, so although -- it's just
4 formatted according to one of the templates that Gonzalez
5 discloses. So although the Gonzalez reference discloses that
6 you can print out the article from the website or a marketing
7 brochure, it comes out in exactly the way the author put it in.
8 Nothing is automatically generated. It's what you see is
9 what you get. What you put in is what you see on the
10 screen. So nowhere is it disclosed that a single set of inputs
11 automatically generates more pages or more articles than
12 what was put in.

13 I believe the Examiner refers to one sentence -- to a
14 couple of sentences in the Gonzalez reference that he
15 believes reads on the automatically generating content. One
16 of the sentences is at paragraph 194 and it simply states that,
17 "The content management application then displays the
18 images and text arranged in the layout of the selected
19 template." But that's not automatically generating
20 additional pages. The author sees the template he's going to
21 input content into and he does that and then it shows up in
22 that format. There's no automatic generation.

1 The second sentence the Examiner relies on is
2 paragraph 209. And this paragraph says, “Click a Submit
3 button to view the edited article. At this point the article is
4 laid out in accordance with the template that the author used
5 to create the article.” So this teaching also doesn’t meet the
6 limitation of automatically generating pages because it’s just
7 viewing what the author put into the template.

8 And there’s absolutely no disclosure in Gonzalez that
9 any template can be designed to do what this claim says,
10 which is to generate pages for printing out a hardcover book
11 where the pages will be oriented in diametric contraposition.
12 Clearly, that’s not what a website publishing or web pages
13 are designed to do. There’s a flat screen. You don’t read it
14 to an audience typically.

15 And none of the secondary references that the
16 Examiner cited remedy this deficiency and none of them
17 disclosed the automatically generating additional pages.
18 The Scocca reference -- I’m not sure I’m pronouncing that
19 right at all -- discloses a children’s book publishing kit
20 whereby children draw pictures and they write captions for
21 the images that they draw on a separate page, they mail it
22 back to the publisher, and the publisher assembles it into a

1 book for them. So like Gonzalez, whatever the children
2 draw and write is what the publisher puts together and sends
3 back. There's no automatic generation.

4 The prior art reference, the former Clements 172
5 patent, which was the earlier invention of the diametrically
6 contraposed book, that reference also requires the user to
7 physically input these insertions pages of the drawings on
8 one side and then the text or the drawing on another side
9 into a storybook. Although the pages can be made using a
10 computer or the image for the diametrically contraposed
11 page can be photocopied, the pages are inserted into the
12 book and nothing is automatically generated. They're just
13 stuck into cover sheets, clear plastic cover sheets, by the
14 user. So all that reference teaches is the notion of the
15 diametric contraposition, but not any software or automatic
16 generation.

17 And the other two references, Schubert and Schach,
18 don't remedy the deficiency. Schubert is cited merely for
19 disclosing copyright information. And this reference
20 discloses an accordion-style recordkeeping book to write
21 down your banking and other information so that when you
22 pass away somebody can easily find a copy of it. It's sort of

1 in opposite to the present invention. And Schach discloses a
2 do-it-yourself romance novel kit. That comes in a format
3 that has a front cover and a foam core, and there's a
4 questionnaire in there that the user fills out, sends it back to
5 the publisher, who sends them back sort of a personalized
6 romance novel based on the questionnaire. That's not
7 anything about automatically generating content or adding
8 content.

9 JUDGE KAUFFMAN: When you were talking about
10 automatically generating content you made it sound like, and
11 maybe I misunderstood, that one set of inputs would
12 generate two sets of outputs. And I'm having trouble
13 understanding that from the claim, which looks to me like a
14 first set of inputs has a first set of outputs and a second set of
15 inputs has a second set of outputs.

16 MS. AMOROSO: Okay. Well, the first set of inputs
17 is your title, author, picture, and from that you get the cover
18 page and the title pages and the copyright information just
19 from limited input. And then the second set of inputs is just
20 your picture and your story to go along with the picture, and
21 then you automatically get the diametrically contraposed
22 other page, second page.

1 And so the second claim limitation that I believe none
2 of the references disclose or suggest is having the book
3 assembly indicia actually printed on the pages, which is
4 what the software does, telling you how to assemble the
5 pages so that they're in the diametrically contraposed
6 formats into the final product. And I believe that's in Step G
7 of the claim.

8 So this is also automatically generated by the
9 software. And this is not disclosed in the primary reference,
10 Gonzalez, because Gonzalez is not concerned with
11 outputting a product such as a storybook. It's a web
12 publishing software to manage content among an author,
13 editor, and publisher. So why would Gonzalez be modified
14 to put instructions for assembling a printed product
15 anywhere? Gonzalez talks about printing a product, but they
16 talk about printing marketing brochures. And if you're
17 giving somebody a marketing brochure there's not going to
18 be instructions along the top of the brochure on how to put it
19 together yourself.

20 JUDGE KAUFFMAN: In your brief you talk about
21 how those instructions are functionally related to the
22 substrate that they're on and that this case is like Gulak?

1 MS. AMOROSO: Yes, yes. Yes, and I'm going to
2 get there in a minute.

3 JUDGE KAUFFMAN: Okay.

4 MS. AMOROSO: So the primary reference that the
5 Examiner relies on to support this is, again, the Scocca
6 children's book patent where they have a separate
7 instruction sheet, this goes in that patent, that instructs the
8 child to use this cardboard template and draw the picture
9 here, and don't go out of the margins, and write your
10 storybook here. That's not instructions for assembling a
11 book because the children send it back to the publisher who
12 assembles it for them.

13 And so in response to the arguments that we made
14 during prosecution, the Examiner did contend that the
15 printed matter, you know, doesn't confer patentability. It's
16 non-functional, descriptive material, but it's wrong for the
17 reasons that we stated in the reply brief. The printed matter
18 is functionally related to the substrate of the book because it
19 tells you on each page how to assemble it and where to put it
20 in relation to the other pages, so you get the diametrically
21 contraposed pages. Because you could see how it would be
22 easy for things to get out of order in something like that

1 where your corresponding images are on two different sides
2 of two different pieces of paper. So they have to be
3 assembled in the correct order for the product to work.

4 That's not an issue in the Scocca prior art reference or
5 the Gonzalez reference because it Scocca the publisher's
6 assembling it and there's no special format, it's just a regular
7 book. And in Gonzalez it's just a web publishing. So it's
8 clearly functionally related because it tells you how to print
9 and then assemble the pages.

10 So this is in contrast to a product that is merely
11 relying on a set of instructions to confer patentability to
12 what might be a non-patentable combination of prior art
13 elements. So, for example, if you just assemble elements
14 into a diagnostic kit, like an antibody and a detection reagent
15 that people were doing without them being in a kit, and then
16 you try to confer patentability by saying, okay, we're going
17 to tell you now how to do the diagnosis, those are the kind
18 of inventions where printed material has said not to be
19 functionally related to the substrate because it doesn't add
20 anything to the combination of old elements. But here it's
21 functionally related because it tells you how to put the
22

1 product together, which is required is a child is going to do
2 this.

3 So instead, I think, to me, these claim limitations, the
4 Examiner can have only relied on the teachings of the
5 present application, which is hindsight. And I think there
6 are two principle indicia of hindsight in this Examiner's
7 rejections.

8 First, Gonzalez, the primary reference, is non-
9 analogous art and should not have been used. Website
10 publishing is not readily applicable to physical book
11 publishing. None of the templates disclosed in Gonzalez are
12 said to be designed to result in printed matter in any special
13 format, let alone diametric contraposition. And, you know,
14 as I said before, it should be evident that that would not
15 work for web publishing. You know, to the extent he
16 mentions that you can print out from the website, it's, again,
17 what you see is what you get.

18 Now, it's true that applicable law does permit non-
19 analogous art to be used to make obviousness rejections in
20 some cases, but in order for a reference that's outside the
21 field of endeavor of the invention to be used, it must be
22 reasonably pertinent to the problem faced by the inventor.

1 Okay? So the Federal Circuit has held that in order to be
2 reasonably pertinent, it must logically commend itself to the
3 inventor's intention. Okay? And I think I explained the
4 problem earlier with reading to a group of children, so it
5 facilitates it, the diametric contraposition. And the invention
6 here is just basically -- is assisting that and automating that
7 and enhancing that so you put minimal input in and get more
8 output.

9 Gonzalez is not reasonably pertinent to that. It
10 doesn't remotely address the problem to be solved by the
11 invention, which is to assist a user to use software to
12 produce and print this diametrically contraposed storybook.
13 And so a skilled artisan seeking to possibly automate
14 production of hardcopy literature wouldn't look to
15 Gonzalez. You wouldn't look because Gonzalez is
16 primarily concerned with workflow management on a
17 website.

18 And *KSR* did not change the applicable federal law
19 that the non-analogous reference has to be reasonably
20 pertinent to the problem to be solved. In fact, this past
21 September, they just reinforced it in the *K-TEC v. Vitamax*
22 case. So Gonzalez is just non-analogous. It's not designed

1 to print hardcopy books, let alone in any special format.
2 So the second hallmark, I think, of improper hindsight
3 is that you would have to redesign Gonzalez to adapt it to do
4 what the software of the present invention -- with the
5 method of the present invention does. It would have to be
6 converted from the system of managing workflow among
7 three people for online publishing for a system for paper
8 publishing. And there's applicable law that says when the
9 principle operation of the primary reference has to be
10 redesigned in order to make the combination, that's probably
11 not the right reference to be using in an obviousness
12 rejection. So just because it might be routine for a skilled
13 software developer to redesign Gonzalez to adapt it doesn't
14 mean they would because the reference as a whole would
15 not have logically commended itself to the inventor's
16 intention, an inventor looking to make -- to print out a book.
17 I think the final problem with the Examiner's
18 rejection is that the Supreme Court and KSR held that there
19 must be some articulated reasoning with rational
20 underpinnings why skilled artisans would combine these
21 references that are not merely conclusory. And so it appears
22 here that the Examiner, you know, based his rejections using

1 the rationale that finds obviousness by combining known
2 elements in known ways to yield predictable results. But he
3 did not really provide valid rationales why one would have
4 specifically adapted the system of Gonzalez primarily
5 designed for what-you-see-is-what-you-get web publishing
6 and one-dimensional output to make a non-web-based book.
7 And then on top of that, you would have had to gone a step
8 further, found the Scocca reference, which is a hardcover
9 children's book, and read that reference and, from that,
10 decided to take the instructions sheet in Scocca and change
11 the instructions from instructing you on how to make
12 content to how to assemble content, and then make the
13 decision not even to put the instructions on a separate sheet,
14 but to put them at the top of a page. And his reasons for
15 why it would have been obviousness are just to assist an
16 amateur storybook publisher in making a professional-
17 looking book without outside assistance.

18 I think these are generic. Essentially any reference
19 disclosing any sort of computer-assisted publishing content
20 would have sufficed to make this rejection, and I think that's
21 exactly what he did using Gonzalez. He basically looked for
22 template and software and he came up with Gonzalez, and

1 he applied that in the rejection. And it doesn't explain why
2 one of skill in the art would have found these five references
3 and then specifically modified them, some of them very
4 divergent, and redesigned the Gonzalez software to make
5 hard copies of books.

6

7 One of the reasons he cited was efficiency. Well, it's
8 not really efficient when you have to redesign the software,
9 the primary invention, to come up with your efficiency
10 rationale.

11 So it seems to me like the Examiner's rejection is
12 based on his opinion basically that it would have just been
13 obvious to modify the prior Clements storybook using
14 computer software. So he simply cited any reference using
15 software that would get you there and I think he
16 impermissibly applied a per se rule that it's obvious to
17 automate any manual process, and he didn't. It's not always
18 obvious to automate or partially automate a manual process,
19 especially here where there's enhancements to the process.
20 You're putting in minimal information and getting out a
21 finished product that contains more than what you put in.
22 This is not simply automating the manual process of the

1 Clements 172 book where the children were physically
2 drawing the pages and writing on them and sticking them
3 into page holders.

4 So I think the Examiner wrongly cited that per se rule
5 without any rationales that provide a nexus between the
6 prior art and what the invention actually is. His rationales
7 are generic and the fact that he had to use five references,
8 including an accordion-shaped copying or bank account
9 information reference, I think is evidence that he was just
10 finding any reference that would have the isolated elements
11 he needed to make the claim limitations and putting them
12 together, saying it would have been obvious, it would be
13 more efficient, and it would be more professional-looking,
14 and everybody knows you put copyright information on a
15 book. So I think it was basically the easy way out and he
16 did not make is prima facie case.

17 JUDGE KAUFFMAN: Judge Hoelter, any questions?

18 JUDGE HOELTER: No, no.

19 JUDGE KAUFFMAN: Judge Jung?

20 JUDGE JUNG: No, I have no questions.

21 JUDGE KAUFFMAN: Did you have anything else
22 you'd like to add?

1 MS. AMOROSO: I don't believe so. I think I
2 highlighted the main points. I mean, I wasn't going to
3 regurgitate the brief to you.

4 JUDGE KAUFFMAN: Well, thank you for coming
5 today. Thank you, Mr. Clements.

6 MS. AMOROSO: Thank you.

7 (Whereupon, the proceedings at 1:50 p.m. were
8 concluded.)